REMARKS/ARGUMENTS

Applicants cancel claims 1-79 and add new claims 80-111. No new matter has been added with this Response. Applicants submit that current claims 80-111 are now in condition for allowance. Reconsideration of the rejections discussed in light of the newly-added claims and the following remarks is therefore respectfully solicited.

In the Non-Final Office Action mailed April 14, 2005, the Examiner rejected claims 1-79 variously under 35 U.S.C. § 102 and 35 U.S.C. § 103. In particular, the Examiner rejected claims 1-5, 7, 8-11, 12, 15, 24, 25, 28-36, 38, 39, 42, 43, 46 and 51 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,026,376 to Kenney (hereinafter "Kenney") in view of U.S. Patent 5,400,402 to Garfinkle (hereinafter "Garfinkle"), and claims 6, 13, 14, 37, 44, 45 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Kenney in view of Garfinkle and further in view of U.S. Patent 5,485,197 to Hoarty (hereinafter "Hoarty"). The Examiner stated that Hoarty teaches a video distribution system wherein selectable content items are displayed upon a rotating carousel, providing an interactive object which is interesting for users to manipulate. The Examiner further stated that it would have been obvious at the time to a person of ordinary skill in the art to modify the interface and method disclosed by Kenney and Garfinkle for the benefit of providing an interactive selection display that is interesting to users to manipulate.

Applicants submit that the Kenney, Garfinkle, or Hoarty references do not teach all of the elements of Applicants' claims, either alone or in combination. In Applicants' claims, the user interface includes a simulation of lateral motion of images in each row to simulate boxes on a carousel rack in a video rental store. Virtual video box images of the content items are represented in a virtual carousel of selectable virtual video box images capable of simulated movement so that the spinning of a video rental store carousel is simulated on the user interface. This feature of Applicants' newly-added claims is not taught by Hoarty as suggested by the Examiner. Instead, Hoarty teaches a carousel display for interactive cable television services that displays channel menu selections. Hoarty specifically teaches that the carousel shows a plurality of faces, including a frontal face showing two or more menu choices. Additional side faces are shown in dimension to indicate additional menu choices available when the carousel is rotated. Hoarty shows this carousel representation in Figures 35-41. (Hoarty, col. 18, line 40 – col. 19, line 18.) However, nowhere

does Hoarty describe its carousel as simulating selections available in a video store as in Applicants' claims – Hoarty is limited to channel selections available to a viewer of television channels. (Hoarty, col. 19, lines 57-64.) Additionally, Figures 35-41 of Hoarty are different from Applicants' Figure 5, which shows rows of video selections available in its carousel simulation. Accordingly, Applicants submit that the rejection under 35 U.S.C. § 103(a) is improper.

Additionally, Applicants submit that the rejections under 35 U.S.C. § 103(a) do not properly recite a motivation to combine the cited references to arrive at Applicants' claimed invention. The fact that discrete elements within the claims can be found somewhere in the prior art, and "can be used" in combination, does not, without more, render the combination unpatentable.[1] To the contrary, where the rejection depends on a combination of elements from prior art references, the Examiner must identify some teaching, suggestion or motivation to combine the references.[2] "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight."[3] No proper teaching, suggestion or motivation to combine has been identified in the present case.

A teaching of every limitation therefore is not determinative. A motivation to combine the specific elements into the claimed invention must be identified. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness."[4] The motivation to combine the specific elements must be specifically taught.[5]

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[1] *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) ("As this court has stated, 'virtually all [inventions] are combinations of old elements.'").

[2] *See, e.g., In re Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456.

[3] *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

[4] *See also In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997) ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

[5] *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (*quoting C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by

Here, the Examiner's statement does not provide adequate motivation to combine specific elements of Kenney, Garfinkle, and Hoarty into the single claimed invention. Applicants' invention simulates the appearance of a video rental store on a user interface. However, in discussing the motivation to combine Kenney, Garfinkle, and Hoarty, the Examiner states it would have been obvious at the time to a person of ordinary skill in the art to modify Kenney and Garfinkle with Hoarty "for the benefit of providing an interactive selection display that is interesting to users to manipulate." At the very best, this may be suitable motivation to use the elements purportedly taught by Kenney, Garfinkle and Hoarty in a general sense. But, they do not provide the motivation to combine the specific elements of Kenney and Garfinkle with Hoarty's carousel display for interactive cable television services to arrive at the presently claimed invention, which provides a user interface which shows users content items for selection as if they were present inside a video rental store.

Applicants respectfully submit that in light of the above remarks, there is a clear deficiency in the prima facie case in support of the Examiner's rejections. Applicants therefore respectfully submit that the remaining rejection under 35 U.S.C. § 103(a) be withdrawn, and that the remaining claims are in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (213) 896-6897.

Respectfully submitted,

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showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").